In re Application of: Ilan Shalev
Serial No.: 10/509,348
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Examiner: Mehta, Bhisma
Group Art Unit: 3767
Attorney Docket: 35292

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-15, 19-24, 26-35, 39, 44-47, 50-53 are currently pending in this Application. Claims 25, 36-38, 40-43, 48-49 have been withdrawn from consideration. Claims 1-15, 19-24, 26-30, 32-35, 39, and 44-47 have been rejected under 35 U.S.C. *§* 102. Claims 35, 49 have been rejected under 35 U.S.C. § 103. Claims 16-18 have been canceled herewith. Claims 1, 5-10 have been amended herewith. New claims 51-53 have been added herewith.

Election/Restrictions

In section 1 of the United States Patent and Trademark Final Office Action mailed April 8, 2008 (hereinafter: the report), the examiner withdrew claim 50 from consideration as being directed to a non-elected invention. The Examiner argues that claim 50 is drawn to a nonelected species as the elected species, shown in Figures 2A, 2B, 2C, and 2D, has extensions which do provide a channel of fluid communication through which a fluid sample can be conducted to outside of the body channel.

Applicant disagrees. Figure 2A, which is part of species I, depicts a cut-away side view an exemplary catheter that meets the limitation which is provided in Claim 50. In particular, Numeral 126 of Figure 2A depicts extensions which *do not provide a channel of fluid communication through which a fluid sample can be conducted to outside of the body tissue*. The extensions, which are depicted in Figure 2A, are designed to extend away from when they are caused to expand by the introduction of an expansion fluid and do not provide a channel through which a fluid sample can be conducted to outside of the body tissue, see paragraph [0067] in page 4 of the specification of the present application.

In the light of the above, Applicant believes that Claim 50 is not directed to an invention that is independent or distinct from the invention which is claimed in

amended claim 1 and therefore should not be withdrawn from consideration as being directed to a non-elected invention.

Claim Objections

In section 2 of the report, the examiner objected to claims 5 – 10 in which the applicant uses the phrase "a said impediment", and the alternative phrase "the impediment" was suggested. In claims 5-10, all instances of the phrase "a said impediment" have been replaced by the phrase "the impediment".

35 U.S.C. § 102 Rejections

In section 4 of the report, claims 1-15, 19-24, 26-30, 32-35, and 44-47 have been rejected under 35 U.S.C. §102(b) as being anticipated by *Barry* in U.S. Patent No. 5,857,998. (hereinafter: *Barry*). It is submitted in response that claim 1 (and claims 2-15, 19-24, 26-30, 32-35, and 44-47 dependent thereon) are patentable, in the light of arguments set forth below.

Applicant amended claim 1 to add the limitation of dependent claim 49. Amended claim 1 now teaches an apparatus comprising a hollow tube characterized by *a length of no more than 10 centimeters when planted in a vein.* This limitation distinguishes the claimed invention from *Barry* and the other cited references.

As stated by the examiner in section 7 of the report, *Barry* does not teach, implicitly or explicitly, a catheter or a hollow tube of no more than 10 centimeters. *Barry particularly relates to a stent for delivering a therapeutic agent therefrom and a method and system for delivery of a therapeutic agent to replenish the stent* see column 1, lines 16-20 of *Barry*. As commonly known, stents may be positioned in arteries and other vessels which are located more than 10 centimeters from a catheter's point of entry in a vein. The delivery of therapeutic agents to such stents requires a hollow tube which is much longer than 10 centimeters.

In particular, *Barry* describes a catheter for providing a treatment to cardiovascular diseases, such as angioplasty, see column 6, line 53, column 10, and line 20 of *Barry*. During the treatment, the catheter is used for positioning a stent within an artery such as the coronary artery and/or for releasing a therapeutic agent in proximity to the treated artery. In order to allow the releasing of the agent and/or the positioning of the stent the catheter has to be guided through the vessel to the site of an irregularity, see abstract of *Barry*. Such guidance clearly requires a catheter which is several tens of centimeters. Based on the above, Applicant asserts that currently amended claim 1 is novel as not being anticipated by *Barry* and that dependent claims 2-15, 19-24, 26-30, 32-35, and 44-47 are consequently allowable as being dependent on an allowable main claim.

Reference is now made to the nonobviousness of amended claim 1. In section 7 of the report, claim 49 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Barry*. In this section the examiner agrees that *Barry* is silent on the specifics of the hollow tube having a length of more than 10 centimeters. The examiner further argues that the instant disclosure of *Barry* describes the parameter of length as being merely preferable, and does not describe it contributing any unexpected results to the tube. This is not correct. *Barry* explicitly describes a *catheter that can be employed as a common angioplastic catheter for treating, for example, stenotic irregularities by dilation of the vessel proximate the stenosis*, see column 10, lines 20-23 of *Barry*. As known to the skilled in the art, a *common angioplastic catheter* is used for treating narrowed or totally obstructed blood vessels, such as coronary arteries, in angioplasty procedures. In order perform such angioplasty procedures the *common angioplastic catheter* is guided through the body of the patient to a site of the stenosis or blockage. As the guidance is performed via the coronary arteries, a guidance hollow tube which is at least several tens of centimeters long is required. By defining the *catheter* as a *common angioplastic catheter*, *Barry* actually teaches away from the amended claim 1 which is *adapted to be placed through a body*

tissue and implanted in a vein for the purpose of intake of fluid and not for such angioplastic procedures.

It should be noted that there is no evidence or suggestion in *Barry* of the configuration which is described in amended claim 1. Further, the Examiner has not provided any evidence that such a configuration was conventional in the art.

Based on the above, Applicant asserts that currently amended claim 1 is not obvious in view of *Barry* and that dependent claims 2-15, 19-24, 26-30, 32-35, and 44-47 are consequently allowable as being dependent on an allowable main claim.

Applicant added new claims 51-53. Claims 51-52 are described in page 2, paragraph 26 of the specification of the present application. In support of claims 51 and 52, the description states that the external section may be, for example, thicker or winged, to prevent entry into the body. In support of claim 53, the description states that while the term "catheter" is used, any type of port may be used, including a short port adapted for entering a vein. New claims 51-53 believed to be allowable as being dependent on an allowable main claim.

35 U.S.C. § 103 Rejections

In section 6 of the report, claim 31 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Barry* in view of Zadno-Azizi in US Patent No. 6,958,059 (hereinafter *Zadno-Azizi*). It is submitted in response that claim 31 is patentable, in the light of arguments set forth below

The arguments made above in respect of the novelty and nonobviousness of amended claim 1 apply to claim 31 and based on that, Applicant asserts that dependent claim 31 is consequently allowable as being dependent on an allowable main claim.

In addition, it should be mentioned that *Zadno-Azizi*, relates to implementing a catheter for treating an intravascular occlusion see column 3, line 7 of *Zadno-Azizi*, or stenosis see column 5, line 29 of *Zadno-Azizi*. Such a catheter has to be longer than 10

centimeters as it designed to reach saphenous vein grafts, coronary arteries, and cerebral arteries. In various examples in column 7, line 7 to column 7 line 15 *Zadno-Azizi* discusses lengths of 160 to about 320 centimeters, 180 centimeters, and 300 centimeters. *Zadno-Azizi*, like *Barry*, does not teach, implicitly or explicitly a catheter shorter than 10 centimeters.

As neither *Zadno-Azizi* nor *Barry* describe a catheter, a hollow tube, or any other guiding element which is shorter than 10 centimeters, it is clear that the combination thereof cannot result in the apparatus of amended claim 1 that comprises a hollow tube characterized by a length of no more than 10 centimeters.

In view of the above amendments and remarks it is respectfully submitted that claims 1-15, 19-24, 26-35, 39, 44-47, and 51-53 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

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Enclosures:

- Petition for Extension (Two Months)